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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Woo Sung Lee

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HUSCH BLACKWELL SANDERS LLP

190 Carondelet Plaza

Suite 600

ST. LOUIS, MO 63105

EXAMINER

UBER, NATHAN C

ART UNIT

PAPER NUMBER

3622

NOTIFICATION DATE

DELIVERY MODE

12/10/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

pto-sl@huschblackwell.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/599,923	<b>Applicant(s)</b> LEE, WOO SUNG	
	<b>Examiner</b> NATHAN C. UBER	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-8,10,12,15,16,21 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-8,10,12,15, 16, 21 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Status of Claims**

1. This action is in reply to the amendment filed on 25 August 2009.
2. Claims 1, 6, 10, 21 and 22 have been amended.
3. Claim 14 has been canceled.
4. Claims 1, 3-8, 10, 12, 15, 16, 21 and 22 are currently pending and have been examined.

### **Specification**

5. The amendment filed 25 august 2009 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicant amends the definition of *computer-readable medium* in the original disclosure to no longer include *a transmission medium*. This amendment is evidently not supported by the original disclosure which clearly defines *computer-readable medium* to include *a transmission medium*. Applicant is required to cancel the new matter in the reply to this Office Action.

### **Claim Rejections - 35 USC § 112**

6. The previous rejection of claims 1 and 10 under 112 first paragraph has been sufficiently overcome by Applicant's amendment. The rejection is withdrawn.
7. The previous rejections of claim 7, claim 14 and claims 21 and 22 under 112 second paragraph are moot because Applicant cancelled the material objected to in claim 7 and claims 21 and 22 and because Applicant cancelled claim 14 entirely.

### **Claim Rejections - 35 USC § 101**

8. 35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 21 and 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Applicant amended the preamble of the claims such that the claims are now directed to *computer-readable medium*. The broadest reasonable interpretation of *computer-readable medium* in light of the specification includes carrier waves and signals. Carrier waves and signals are *per se* non-patentable subject matter. For this reason, claims 21 and 22 are rejected under 35 U.S.C. 101 for being directed to non-statutory subject matter. Examiner recommends narrowing the claims by amendment so that they are directed only to the 'hardware devices specially designed to store and perform instructions of a program' (which is supported by the original disclosure on page 31) rather than to both the hardware and the *transmission medium*.

#### Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 3-8, 10, 12, 15, 16, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Davis et al., (U.S. 6,269,361 B1).

#### Claims 1 and 21:

Davis, as shown, discloses the following limitations:

- *defining a plurality of advertisement locations for placement of advertisements in association with keywords, at least one of said advertisement locations including a plurality of unit display zones in association with a predetermined keyword* (see at least column 18, lines 4-21)

and figure 7, a plurality of ad display zones where ads associated with the keyword "zip drives" are placed which constitutes an advertisement location; note Examiner interprets this claim limitation in light of figure 3 of Applicant's specification and its accompanying disclosure),

- *receiving at least one bid data corresponding to a first unit display zone from at least one advertiser, said first unit display zone being one of the plurality of unit display zones associated with said predetermined keyword, each of said at least one bid data indicating a bid price (see at least column 19, lines 8-17 and figure 9, advertiser may specifically place a bid for the first position for a particular keyword, the bid comprising the bid price; see also at least column 12, lines 28-29, bid and keyword),*
- *determining a first winning bid based at least in part on a bid price wherein the determining the first winning bid is performed by a processor (see at least column 9, lines 42-49, the higher bids are perceived and awarded the higher placement zones),*
- *storing said bid data including the first winning bid in a memory (see at least column 19, lines 8-17 and figure 9, advertiser may view current bid prices, inherently the bids are stored; see also column 12, lines 29-39, bid information stored and organized),*
- *determining whether a first advertiser's right to display an advertisement on said first unit display zone is to be terminated, the a first advertiser submitting the first winning bid (see at least column 14, lines 5-9, listings are suspended, i.e. ads are no longer presented when the advertiser account balance is too low),*
- *upon determining that the first advertiser's right to display an advertisement on said first unit display zone is to be terminated retrieving at least a portion of said stored bid data from the memory (Examiner notes that claim scope is*

not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure (MPEP § 2111.04). Accordingly, no patentable weight was given to the following claim language following “*upon determining...*” because this determination is not required and the broadest reasonable interpretation of the claim is that the determination does not occur; see at least column 20, lines 14-31, after bid is deleted and ad is no longer presented, the bid data is retained),

- *determining a second winning bid without soliciting new bids, based at least in part on a bid price among said retrieved bid data for placement of an advertisement on said first unit display zone in association with search result list generated in response to a search query associated with said predetermined keyword, said retrieved bid data including previously entered bids for said first unit display zone* (see at least column 9, lines 42-49, the higher bids are perceived and awarded the higher placement zones, inherently is the highest bid disappears, then the next highest bid becomes the current highest bid; see also at least column 19, lines 8-17 and figure 9, advertiser may specifically place a bid for the first position for a particular keyword, the bid comprising the bid price; see also at least column 12, lines 28-29, bid and keyword),
- *transferring said right to display an advertisement on said first unit display zone from said first advertiser to a second advertiser which has submitted said second winning bid* (see at least column 9, lines 42-49, the higher bids are perceived and awarded the higher placement zones, inherently is the highest bid disappears, then the next highest bid becomes the current highest bid),

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- *displaying an advertisement of the second advertiser on said first unit display zone* (see at least column 9, lines 42-49, the higher bids are perceived and awarded the higher placement zones, inherently is the highest bid disappears, then the next highest bid becomes the current highest bid),
- *upon termination of the first advertiser's right to display an advertisement on said first unit display zone, performing a re-bid process for a second unit display zone wherein a winning bid for the second unit display zone is determined based at least in part on a bid price among previously stored bids for the second unit display zone including the first advertiser's bid if the first advertiser's bid was made for the second unit display zone as well as the first unit display zone* (Examiner notes that claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure (MPEP § 2111.04). Accordingly, no patentable weight was given to the following claim language following “*upon determining...*” because this determination is not required and the broadest reasonable interpretation of the claim is that the determination does not occur; see at least column 19, lines 38-58, changing the position of the ad in the result list).

**Claim 3:**

Davis, as shown, discloses the following limitation:

- *if said second advertiser has submitted a plurality of winning bids corresponding to a plurality of said unit display zones associated with said predetermined keyword, one unit display zone is assigned to said second advertiser in accordance with at least one predetermined display priority condition* (Examiner notes that claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure

(MPEP § 2111.04). Accordingly, no patentable weight was given to claim 3 because the broadest reasonable interpretation of the claim is that the *if* condition is not satisfied; see at least column 18, lines 23-26, winning bids, i.e. bids with the same bid amount for the same keyword, are awarded preferred placement based on which bid was received first, i.e. a priority condition).

**Claim 4:**

Davis, as shown, discloses the following limitation:

- *the predetermined display priority condition is determined based at least in part on review of cost-per-click pricing model* (see at least column 9, lines 42-43, higher bid gets better placement or first priority for a given position; see also at least column 10, lines 2-6, paid listing comprise a cost per click).

**Claim 15**

Davis, as shown, discloses the following limitation:

- *the predetermined display priority condition is determined based at least in part on review of selection by said second advertiser* (see at least figure 9, line advertisers can view bids and placements for each ad).

**Claim 5:**

Davis, as shown, discloses the following limitation:

- *wherein said bid data include payable fee per single click, and the step of determining a second winning bid comprises the step of: determining a second winning bid in accordance with said payable fee per single click* (see at least column 9, lines 42-43, higher bid gets better placement or first priority for a given position; see also at least column 10, lines 2-6, paid listing comprise a cost per click).

**Claim 6:**

Davis, as shown, discloses the following limitation:

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- *ordering said stored bid data in accordance with payable fee per single click, said payable fee per single click being included in said bid data, wherein the step (g) of determining a second winning bid determines said second winning bid in accordance with the order of said bid data (see at least figure 7, ordering the ads in accordance with bid price; see also at least column 19, lines 8-17 and figure 9, advertiser may specifically place a bid for the first position for a particular keyword, the bid comprising the bid price).*

**Claim 7:**

Davis, as shown, discloses the following limitation:

- *the step of determining a second winning bid comprises the steps of ordering said stored bid data and re-ordering said stored bid data if new bid data has been submitted determining a second winning bid in accordance with the order of said bid data (see at least column 20, lines 14-31, after bid is deleted and ad is not longer presented, the bid data is retained; see also at least column 9, lines 42-49, the higher bids are perceived and awarded the higher placement zones, inherently is the highest bid disappears, then the next highest bid becomes the current highest bid).*

**Claim 8:**

Davis, as shown, discloses the following limitation:

- *wherein the predetermined transfer condition is associated with an expiration of a predetermined contract for the search listing (see at least column 14, lines 5-9, listings are suspended, i.e. ads are no longer presented when the advertiser account balance is too low).*

**Claims 10 and 22:**

Davis, as shown, discloses the following limitations:

- *receiving a plurality of bids for a particular placement position of advertisement in association with a predetermined keyword, said each bid*

*indicating a bid price and an advertisement (see at least column 9, lines 19-41, bids are received for keywords from advertisers),*

- *determining a first winning bid based at least in part on a bid price wherein the determining the first winning bid is performed by a processor (see at least column 9, lines 42-49, the higher bids are perceived and awarded the higher placement zones),*
- *storing said bids including the first winning bid in a memory (see at least column 19, lines 8-17 and figure 9, advertiser may view current bid prices, inherently the bids are stored; see also column 12, lines 29-39, bid information stored and organized),*
- *determining whether a first advertiser's right to display an advertisement on said particular placement position is to be terminated, the first advertiser which submitting the first winning bid (see at least column 14, lines 5-9, listings are suspended, i.e. ads are no longer presented when the advertiser account balance is too low),*
- *upon determining that the first advertiser's right to display an advertisement on said first unit display zone is to be terminated, selecting, based at least in part on review of bid price, a second winning bid without soliciting new bids among said stored bids for said particular placement position of advertisement in association with said predetermined keyword (Examiner notes that claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure (MPEP § 2111.04). Accordingly, no patentable weight was given to the following claim language following "upon determining..." because this determination is not required and the broadest reasonable interpretation of the claim is that the determination does not occur; see at least column 20, lines 14-31, after bid is*

deleted and ad is not longer presented, the bid data is retained; see also at least column 9, lines 42-49, the higher bids are perceived and awarded the higher placement zones, inherently is the highest bid disappears, then the next highest bid becomes the current highest bid; see also at least column 19, lines 8-17 and figure 9, advertiser may specifically place a bid for the first position for a particular keyword, the bid comprising the bid price),

- *transferring said right to display an advertisement on said particular placement position in association with said predetermined keyword from said first advertiser to a second advertiser who has submitted said second winning bid* (see at least column 9, lines 42-49, the higher bids are perceived and awarded the higher placement zones, inherently is the highest bid disappears, then the next highest bid becomes the current highest bid),
- *displaying an advertisement of the second advertiser on said particular placement position* (see at least column 9, lines 42-49, the higher bids are perceived and awarded the higher placement zones, inherently is the highest bid disappears, then the next highest bid becomes the current highest bid).

**Claim 12:**

Davis, as shown, discloses the following limitation:

- *if said second advertiser wins bidding for more than one placement position of advertisement in association with said predetermined keyword, one placement position of advertisement in association with said predetermined keyword is assigned to said second advertiser in accordance with a predetermined condition, and wherein said predetermined condition is determined based at least in part on review of cost-per-click pricing model* (Examiner notes that claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure (MPEP §

2111.04). Accordingly, no patentable weight was given to claim 3 because the broadest reasonable interpretation of the claim is that the *if* condition is not satisfied; see at least column 18, lines 23-26, winning bids, i.e. bids with the same bid amount for the same keyword, are awarded preferred placement based on which bid was received first, i.e. a priority condition; see also at least column 9, lines 42-43, higher bid gets better placement or first priority for a given position; see also at least column 10, lines 2-6, paid listing comprise a cost per click).

**Claim 16:**

Davis, as shown, discloses the following limitation:

- *if said second advertiser wins bidding for more than one placement position of advertisement in association with said predetermined keyword, only one placement position of advertisement in association with said predetermined keyword is assigned to said second advertiser in accordance with a predetermined condition, and wherein said predetermined condition is determined based at least in part on review of selection by said second advertiser* (Examiner notes that claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure (MPEP § 2111.04). Accordingly, no patentable weight was given to claim 3 because the broadest reasonable interpretation of the claim is that the *if* condition is not satisfied; see at least column 18, lines 23-26, winning bids, i.e. bids with the same bid amount for the same keyword, are awarded preferred placement based on which bid was received first, i.e. a priority condition; see also at least column 9, lines 42-43, higher bid gets better placement or first priority for a given position; see also at least column 10, lines 2-6, paid listing comprise a cost per click).

### **Response to Arguments**

12. Applicant's arguments filed 25 August 2009 have been fully considered but they are not persuasive. Applicant's arguments are addressed individually below. Generally Examiner believes, based on Applicant's response, that Applicant has not recognized the breadth of Applicant's claim language which was demonstrated in the previous Office action. The majority of Applicant's arguments rest on a difference of opinion between Applicant and Examiner on the interpretation of the claim language. Examiner must give the claim language the broadest reasonable interpretation, and Applicant may then amend the claims such that the scope of the claims accurately reflect the invention and prohibit an interpretation that is either taught by the art of record or that Applicant disagrees with. Here Applicant made no claim amendments to address the prior art rejection and stated the fact on the first page of Applicant's remarks. Accordingly, the rejection is maintained and Applicant's arguments are addressed below.
13. Applicant's first argument is with regard to claims 1 and 21 (see pages 12-15 of Applicant's remarks). Applicant states "[t]he claimed invention is directed to a method of automatic re-bidding process for a specific advertisement position on a web page..." (*Id.* at 12). This statement is false. Claim 1 clearly states that it is "a method for controlling display of a keyword advertisement" and claim 21 is not a method, it is a computer-readable medium. Applicant then attempts to characterize/explain the meaning of terms and summarize the 're-bidding' aspect of the invention but Applicant never provides a basis for this explanation, for example where in the original disclosure Examiner might find support for this explanation (see ¶15 of Applicant's remarks). (Examiner notes that page 29 and figure 12 disclose a re-bid process that is different from the explanation in Applicant's remarks) Accordingly, Examiner will rely on Examiner's previous interpretation of the claim language based on Examiner's analysis of the original disclosure rather than rely on Applicant's argument alone.
14. Applicant further explains that the 're-bidding process' is initiated upon determining that a predetermined transfer condition is satisfied, and defines the term 'predetermined transfer

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condition' (see ¶6 of Applicant's remarks) This term is not found within claims 1 and 21, therefore this argument is moot.

15. Applicant then argues that the language 'upon determining' and 'upon termination' in the claim does not make the claim limitation optional as interpreted by Examiner. Applicant provides two reasons for this assertion: (1) the "claim language is a condition for the claimed step of 'retrieving the stored bid data from the memory'" (see ¶7 of Applicant's remarks); and (2) according to the MPEP only a limited list of clauses allow for such an interpretation (*Id.*). Neither argument is persuasive. Examiner agrees with Applicant's first argument that the 'upon determining' language is a condition for the claimed step of 'retrieving...' nevertheless the claim does not foreclose the possibility that the advertiser's right to display the ad is *not* to be terminated. The broadest reasonable interpretation of the claim makes the claim language 'upon determining' optional. Applicant's second argument that the MPEP provides a narrow list of clauses that may be interpreted to make claim limitations optional is completely false. The same section of the MPEP that Applicant cites, MPEP §2111.04 clearly states "...examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are..." The MPEP in no way limits this interpretation to the examples provided as Applicant asserts. Further Examiner's interpretation that the determination may not occur comports with Applicant's specification. Winning bids necessarily maintain their position for a period of time. During that time the determination that the right to display the ad at that position is to be terminated does not occur because conversely the right to maintain that ad position still rests with the original winning bid. Examiner further notes with regard to this aspect of Applicant's arguments, that Applicant never addresses the prior art citations for these limitations, rather Applicant only argues against Examiner's interpretation of the claim language. For each claim limitation that Examiner broadly interpreted and indicated to applicant that the broadest interpretation includes an interpretation in which the limitation does not affect the scope of the claim, Examiner also cited the prior art sections that teach the limitations. Examiner did so because Examiner assumes that Applicant will be able to amend the claim language such that all limitations carry patentable weight.

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Applicant's choice to only argue about Examiner's interpretation rather than seeking to address the claim language is somewhat puzzling, especially since Examiner provided prior art references for each limitation and Applicant provides no argument with regard to those references.

16. Applicant next argues against Examiner's inherency finding with regard to a step of determining a second winning bid (see ¶9 and page 15 of Applicant's remarks). Applicant's argument is not persuasive because Applicant is reading limitations into the claim language that do not exist. The claim limitation in question states *determining a second winning bid without soliciting new bids*, as noted the Davis reference determines winning bids for more than one location, the first winning bid going to the first location and the second winning bid going to the second location etcetera. The citation discloses that the higher bids are perceived during the bidding process and awarded the higher placement zones (column 9, lines 4—49). Davis does not use the same language, a second winning bid, as in the claim, so Examiner made the inherency statement to demonstrate that based on Davis' disclosure there are second winning bids determined from the same bidding process for ad display zones. In Davis the first winning bid is determined and placed in the first zone, the second winning bid is determined and placed in the next zone. Applicant argues that Examiner's inherency statement is not appropriate in the context of re-bidding process, but the claim is not directed to re-bidding. Examiner interprets the limitation to be based on the same set of bids because the limitation specifically requires 'without soliciting new bids.' Examiner does not suggest that a result *may* happen, Examiner properly interpreted the process disclosed in Davis and applied that teaching to Applicant's claim language. Further Applicant assumes that Examiner stated that the entire claim limitation was determined to be inherent based on Davis' disclosure (see ¶10 of Applicant's remarks), when in fact Examiner provided several citations to the Davis reference that teach this limitation and only relied on inherency with regard to the 'second winning bid language' as noted above and as noted in the rejection. Examiner has carefully considered Applicant's remarks and finds no errors with Examiner's interpretation of the claims and finds no errors in Examiner's rejection.

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17. Applicant argues with regard to claim 3 that Examiner erred in finding that the broadest reasonable interpretation of the *if* limitation is a negative, i.e. that the condition doesn't occur (see ¶10 and page 16 of Applicant's remarks). Again, as noted in the rejection, Examiner explained that the broadest reasonable interpretation of this limitation (not necessarily all *if* limitations) is that the condition does not occur. Accordingly Examiner indicated that such an interpretation results in the limitation carrying no patentable weight in the claim because it does not limit the invention when the condition does not occur. Nevertheless, as Examiner has done throughout the rejection above, Examiner provided a reference to the prior art that teaches the limitation on the assumption that the condition may occur and that Applicant may amend the claim language such that the condition must occur and the broadest reasonable interpretation is limited to the condition occurring. Applicant provides no argument regarding Examiner's citation to the prior art to teach this limitation. Accordingly, Examiner maintains the rejection as well as Examiner's interpretation of the claim language.
18. Applicants argument with regard to claim 7 is essentially repeated from Applicant's argument with respect to a similar limitation in claims 1 and 21. Briefly Applicant misreads Examiner's rejection and assumes that Examiner's finding of inherency applies to the entire limitation. Contrarily, Examiner highlights the sections of Davis that teach the limitation and only states that the limitation regarding the 'second winning bid' is inherent to the Davis disclosure because the Davis disclosure determines multiple winners for ad placement from the same bidding period. Thus the first winner is determined, and necessarily the next highest bid is the second winner because the second bidder becomes the first highest bid after the first bidder is determined. Applicant argues broadly about the differences between the 'conventional art' and Applicant's invention. This argument is not persuasive because Applicant is not arguing about Davis which is the art of record and the only art relevant to the current rejection. Davis teaches this limitation, the rejection is maintained.
19. Applicants arguments with respect to claims 10 and 22 are similar to Applicant's arguments with respect to claims 1 and 21 (see pages 16 and 17 of Applicant's remarks). Applicant again

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misstates the subject of these claims as methods (claim 22 is a computer readable medium claim) directed to a re-bidding process. The method is not directed to a re-bidding process, it is directed to a method of controlling display of keyword ads. Applicant renews Applicant's objection to Examiner's interpretation of the 'upon' limitations and Examiner's inherency statement and Applicant again fails to address the prior art citations for these claims. These arguments are adequately addressed above with respect to claims 1 and 21.

20. Applicant's argument with respect to claims 12 and 16 is puzzling because it appears to be focused on claim 3 which was previously addressed above. Examiner assumes that Applicant intended to rely on Applicant's argument from claim 3 for claims 12 and 16 due to the similarity of the claims. Likewise Examiner relies on Examiner's response above with respect to claim 3 for claims 12 and 16.

### Conclusion

21. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
22. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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- 23.** Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Nathan C Uber** whose telephone number is **571.270.3923**. The Examiner can normally be reached on Monday-Friday, 8:30am-4:00pm EST. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Eric Stamber** can be reached at **571.272.6724**.
- 24.** Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://portal.uspto.gov/external/portal/pair> <<http://pair-direct.uspto.gov>>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).
- 25.** Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**P.O. Box 1450, Alexandria, VA 22313-1450**

or faxed to **571-273-8300**.

- 26.** Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building

401 Dulany Street

Alexandria, VA 22314.

/Nathan C Uber/ Examiner, Art Unit 3622  
3 December 2009

/Arthur Duran/  
Primary Examiner, Art Unit 3622